

RECEIVED  
CENTRAL FAX CENTER

OCT 19 2005

Facsimile

Pitney Bowes Inc.

Assistant Deputy General  
Corporate Counsel,  
Intellectual Property &  
Technology Law  
35 Waterview Drive  
P.O. Box 3000  
Shelton, CT 06484-8000203-924-3880  
203-924-3919 Fax  
Steve.shapiro@pb.com  
www.pitneybowes.com

To: Patent and Trademark Office  
Attention: Examiner Tan D. Nguyen, Group Art Unit: 3629  
Facsimile No.: 1-703-872-9306  
From: Steven J. Shapiro  
Date: October 19, 2005  
Subject: Serial No.: 09/474,909  
Pages: 11 (including this cover)

---

Re: U.S. Patent Application Serial No.: 09/474,909  
Confirmation No. 3629  
Our Docket No. E-954

Enclosed please find a Brief on Appeal in the above referenced application.

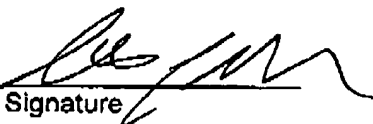
**CERTIFICATION OF FACSIMILE TRANSMISSION**

I hereby certify that the following correspondence is being transmitted  
Via Facsimile to:

Patent and Trademark Office  
Attention: Examiner Tan D. Nguyen, Group Art Unit: 3629  
Facsimile No. 1-703-872-9306

October 19, 2005  
Date of Transmission

Steven J. Shapiro  
Name of Registered Rep.

  
Signature

October 19, 2005  
Date

RECEIVED  
CENTRAL FAX CENTER

OCT 19 2005

PATENT

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE  
BOARD OF APPEALS AND PATENT INTERFERENCES**RECEIVED  
CENTRAL FAX CENTER

OCT 19 2005

In re patent application of:

) Date: October 19, 2005

Richard D. Marry, et al.

) Attorney Docket No.: E-954

Serial No.: 09/474,909

) Customer No.: 00919

Filed: December 28, 1999

) Group Art Unit: 3629

Confirmation No.: 2919

) Examiner: Tan D. Nguyen

Title:

METHOD OF CALCULATING SORTING COSTS FOR  
CHARGEBACK ACCOUNTING FOR AN INCOMING MAIL SORTING  
APPARATUS**BRIEF ON APPEAL**Commissioner for Patents  
PO Box 1450  
Alexandria, Virginia 22313-1450

Sir:

This Appeal Brief is being filed pursuant to 35 U.S.C. Section 134 from the final rejection of claims 1-3 mailed May 25, 2005. Pursuant to MPEP 1208.02, no fee is believed due because the fee for filing this Brief on Appeal was previously paid for in this application with the filing of a prior Brief on Appeal. However, if fees for this appeal are deemed to be required, authorization is hereby given to charge such fees to deposit account number 16-1885.

**REAL PARTY IN INTEREST**

The real party in interest is Pitney Bowes Inc. which acquired all rights to the above-identified application by way of an assignment which was recorded in the Assignment Branch of

{ 10042140.1 }

- 2 -

the United States Patent and Trademark Office on December 28, 1999, at Reel 010484 and Frame 0516.

### **RELATED APPEALS AND INTERFERENCES**

There are no related Appeals or Interferences which will directly affect or be directly affected by or have a bearing on the Board's decision in the instant appeal.

### **STATUS OF CLAIMS**

The instant application was originally filed with claims 1-6. In the Amendment filed on March 10, 2003, claims 1 and 4 were amended. In an amendment filed on January 07, 2004, claim 1 was amended and claims 4-6 cancelled. In an amendment filed on January 04, 2005 claim 1 was amended. A Response after Final was filed on August 19, 2005 but no amendment of the claims was made in that response. Accordingly, claims 1-3 are currently pending and are being appealed. Appendix A sets forth the pending claims.

### **STATUS OF AMENDMENTS**

There are no outstanding amendments to the claims.

### **SUMMARY OF CLAIMED SUBJECT MATTER**

Prior to discussing the specifics (reference to specification and figures) of independent claim 1, a general conceptual overview of the benefits of the claimed invention is considered warranted. The instant invention is directed toward a method for improving the accuracy for determining mailroom chargeback cost for incoming mail addressees using an incoming mail sorting apparatus. As explained in the background of the invention, there are costs associated with running a mailroom within an organization. The costs of running that mailroom are typically divided between separate cost centers based on some type of cost allocation formula which is not necessarily related to the actual use of the mailroom. The instant invention provides a mechanism for allocating costs to addressees of incoming mail based on the type and quantity of the incoming mail forwarded to that addressee. While the background of the invention discusses how postage costs for outgoing mail can be allocated to different cost

{ I 0 0 4 2 1 4 0 . 1 }

- 3 -

centers based on the types of service and quantities of mail associated with that cost center, there is a fundamental difference when addressing incoming mail. In the outgoing situation the mailer is creating the mailpieces and knows where to allocate the postage costs. In the incoming situation, information must be obtained from the incoming mailpieces themselves and associated with addressee information in an addressee database in order to calculate incoming costs for that particular addressee with respect to the handling of incoming mailpieces. The instant invention provides a method that addresses the incoming mail situation.

Referring specifically to independent claim 1, a method for improving the accuracy for determining mailroom chargeback cost for addressees using an incoming mail sorting apparatus (numeral 8 of fig. 2) having a database (numeral 50 of fig. 2) of addressees is claimed. By way of reference to the steps of Figure 3, the method includes collecting information about each one of a plurality of mailpieces sorted using the incoming mail sorting apparatus, the information used to determine a type of mailpiece and a type of addressee information for each one of the plurality of mailpieces (Page 6 lines 10-21 and page 5 lines 18-30, Figure 3 steps 124, 126, 127). Based on the information collected, the type of mailpiece is determined (step 126, page 5 lines 18-22). The information collected for each mailpiece is associated by the incoming mail sorting apparatus with addressee information from the database of addressees such that for each addressee there is stored a piece count for each type of mailpiece that is incoming to that addressee (step 128, page 6 lines 21-28). An incoming sorting cost for a particular addressee is calculated using the piece count for a particular type of mailpiece associated with the particular addressee along with a predetermined unit price for the particular type of mailpiece (step 136, page 7 lines 4-21).

#### **GROUND'S OF REJECTION TO BE REVIEWED ON APPEAL**

At issue in this Appeal is the propriety of the following rejections:

1. Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants Admitted Prior Art (AAPA) in view of Sansone (U.S. Patent 5,257,196).

{ 1 0 0 4 2 1 4 0 . 1 }

- 4 -

2. Claims 2-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over AAPA/Sansone as applied to claims 1-3, and further in view of PEOPLES (Article 7/1998 "Mission Impossible ...").

3. Claims 1-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlieb (U.S. Pat. No. 6,283,304) in view of Sansone.

4. Claims 2-3 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Gottlieb/Sansone as applied to claims 1-3 and further in view of PEOPLES (Article 7/1998 "Mission Impossible ...").

## **ARGUMENTS**

### **Rejection 1**

The Examiner admits that AAPA does not teach or suggest steps d) and e) of claim 1. However, it is the Examiner's opinion that Sansone allegedly teaches elements d) and e) of claim 1. Applicants submit that such is not the case. Sansone is directed to a system for calculating the total cost for a batch of mail being submitted to a post for delivery by a single mailer. Thus, Sansone is directed to postage cost allocation for outgoing mail. There is no teaching or suggestion in Sansone concerning storing a piece count and type of mailpiece data in association with a database of addressees or calculating incoming sorting cost information for a particular addressee based on the stored piece and mail type information for the particular addressee and a predetermined unit price for each mailpiece type. Sansone isn't even concerned about calculating cost allocations for individual addressees. Sansone simply calculates total postage costs for different classes of mail while taking into account discounts for certain types of pre-sorted mail or for non-presorted mail having zip plus 4 data printed thereon (see column 2 lines 1-42 and column 6 lines 11-56). Even the Examiner's position that Sansone teaches calculating postage based on location is not correct. The zip code reference in Figure 5 simply means that certain discounts are given if mailpieces include zip plus 4 information. The location associated with any particular zip plus 4 location is not relevant to the calculation. What is important to the post is that the zip plus 4 is printed on the mailpiece

{ I 0 0 4 2 1 4 0 . 1 }

- 5 -

because it makes the post's sorting efforts subject to automation thereby improving efficiency. That is why the post gives a discount.

The bottom line is that Sansone does not teach or suggest calculating incoming sorting costs for individual addressees as claimed or the method for accomplishing such calculation using the addressee database that associates mailpiece type and piece count of mailpiece type for each addressee in the database.

Appellants also submit that AAPA does not teach or suggest each of elements a), b) and c) of claim 1 as suggested by the Examiner. AAPA discusses calculating mail costs associated with outgoing mail and charges those costs to specific department accounts. AAPA does not teach or suggest using an incoming mail sorting apparatus to collect information about the mailpieces and to determine the type of mailpiece (i.e. letter, flat, etc.). Further, AAPA does not associate the collected information with addressees in an addressee database. As previously discussed, in AAPA the costs associated with outgoing mail is charged to a department account associated with a sender of the mailpiece. The claimed invention is directed to associating charges with an incoming addressee name.

In view of the above, it is submitted that the Examiner has not established a prima facie case of obviousness for claim 1 as well as claims 2-3 which depend therefrom.

### **Rejection 2**

The Examiner does not submit that PEOPLES teaches or suggests steps d) or e) of claim 1 and only cites PEOPLES for its alleged teachings concerning mail piece information. However, since PEOPLES does not correct the deficiencies of AAPA and Sansone as discussed above for claim 1, it is submitted that claims 2-3 are patentable in view of the combination of AAPA, Sansone, and PEOPLES.

### **Rejection 3**

The Examiner admits Gottlieb does not teach or suggest steps d) and e) of claim 1 and, in the same manner as discussed above regarding Rejection 1, submits that Sansone teaches these steps. The deficiencies of Sansone discussed above for Rejection 1 are thus incorporated herein by reference. Appellants submit that the combination of Gottlieb and Sansone

{ I 0 0 4 2 1 4 0 . 1 }

- 6 -

fail to establish a prima facie case of obviousness for independent claim 1 as well as dependent claims 2 and 3.

In addition to the above, it is submitted that Gottlieb is directed to a mail sorting apparatus 8 that is used to read incoming mailpieces to determine to which of a plurality of bins 18 the mailpiece should be directed. Specific bins collect mailpieces for further delivery to specific locations. Gottlieb also describes the use of thickness sensors (not shown) that are used to determine the thickness of individual mailpieces. The mailpiece thickness data is subsequently used to determine a calculated thickness of the total number of mailpieces in a particular bin 18. Once the calculated thickness for a particular bin reaches a bin full value, the sorting apparatus 8 will not direct any further mailpieces to that bin. Therefore, Gottlieb does not teach or suggest calculating costs associated with incoming mailpieces or, for that matter, outgoing mailpieces. Further, Gottlieb does not collect information to determine a type (flat, letter, etc.) of mailpiece as claimed in steps a) and b). Rather, Gottlieb collects thickness information solely to determine if a particular bin is full. There is no teaching or suggestion in Gottlieb concerning determining the type of mailpiece as claimed.

#### **Rejection 4**

The deficiencies of Gottlieb and Sansone as discussed above in connection with Rejection 3 are applicable to rejection 4 and are hereby incorporated by reference. The Examiner does not submit that PEOPLES teaches or suggests steps d) or e) of claim 1 and only cites PEOPLES for its alleged teachings concerning mail piece information. However, since PEOPLES does not correct the deficiencies of Gottlieb and Sansone as discussed above for claim 1, it is submitted that claims 2-3 are patentable in view of the combination of Gottlieb, Sansone, and PEOPLES.

#### **SUMMARY**

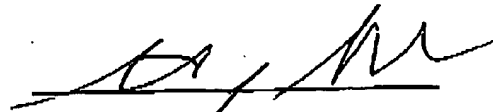
It is submitted for each of the reasons enumerated above that the Examiner has failed to establish a prima facie case of obviousness for each of the appended claims. Appellants

{ 1 0 0 4 2 1 4 0 . 1 }

- 7 -

respectfully request that the Board reverse the Examiner with respect to the outstanding rejections set forth in the final Office Action.

Respectfully submitted,



Steven J. Shapiro  
Reg. No. 35,677  
Attorney for Appellants  
Telephone (203) 924-3880

PITNEY BOWES INC.  
Intellectual Property and  
Technology Law Department  
35 Waterview Drive  
P.O. Box 3000  
Shelton, CT 06484-8000

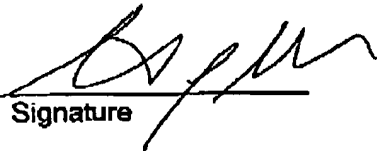
**CERTIFICATE OF FACSIMILE TRANSMISSION**

I hereby certify that this correspondence is being transmitted *via facsimile* to:

Patent and Trademark Office  
Attention: Examiner Tan D. Nguyen, Group Art Unit: 3629  
Facsimile No. 1-703-872-9306

October 19, 2005  
Date of Transmission

Steven J. Shapiro  
Name of Registered Rep.

  
Signature

October 19, 2005  
Date

{ 10042140.1 }

**APPENDIX A - CLAIMS**

**Claim 1.** A method for improving the accuracy for determining mailroom chargeback cost for addressees using an incoming mail sorting apparatus having a database of addressees for use in sorting incoming mailpieces comprising the steps of:

- a) collecting information about each one of a plurality of mailpieces sorted using the incoming mail sorting apparatus, the information used to determine a type of mailpiece and a type of addressee information for each one of the plurality of mailpieces;
- b) determining the type of mailpiece using the information collected in step a);
- c) associating the information about each one of the plurality of mailpieces sorted using the incoming mail sorting apparatus with addressee information from the database of addressees;
- d) storing a piece count for each one of the plurality of mailpieces sorted using the incoming mail sorting apparatus, the piece count stored in association with corresponding addressee information from the database of addressees and said determined type of mailpiece in the incoming mail sorting apparatus; and
- e) calculating incoming sorting cost information using the piece count stored in association with the corresponding addressee using a predetermined unit price for each type of mailpiece and the piece count for each type of mailpiece.

**Claim 2.** The method as claimed in claim 1 wherein the information about each one of the plurality of mailpieces comprises a type of mailpiece selected from the group consisting of: a letter, a flat and a postcard.

**Claim 3.** The method as claimed in claim 1 wherein the information about each one of the plurality of mailpieces comprises a type of addressee information selected from the group consisting of: hand print, hand script, interoffice and interoffice form.

{ 1 0 0 4 2 1 4 0 . 1 }

- 9 -

**APPENDIX B - Evidence**

**None**

**THIS PAGE BLANK (USPTO)**

{ 10042140.1 }

- 10 -

**APPENDIX C – Related Proceedings**

**None**

**THIS PAGE BLANK (USPTO)**

{ 10042140.1 }